

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : Xiaogang Peng
Application No. : 10/763,068
Filed : January 22, 2004
For : Monodisperse Core/Shell and Other Complex Structured
: Nanocrystals and Methods of Preparing the Same
Examiner : Elena Tsoy Lightfoot
Art Unit : 1792
Atty. Docket : 40715-296579

Mail Stop: Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition Regarding Patent Term Adjustment (PTA)
Indicated in Notice of Allowance

Sir:

1. A Notice of Allowance was mailed on February 16, 2010 for the present application. One of the attachments to the Notice of Allowance was a Determination of Patent Term Adjustment Under 35 USC § 154(b) that indicated that the total patent term adjustment (PTA) to date is 0 days. It is believed that the correct total PTA to date is 300 days.

2. The determination of the total PTA of 0 days is erroneous because the U.S. Patent & Trademark Office's (PTO) PTA calculator failed to account for two separate PTO delays. The two PTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008), *aff'd Wyeth et al. v. Dudas*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010). The number of PTA credits of 366 days for PTO delay under 35 USC § 154(b)(1)(A) and 37 CFR § 1.702(a)(1) that is shown on the PTA History (Exhibit A) is correct and agrees with the credit calculated by the PTO. However, this delay only accounts for one of the delays of the PTO. The other delay warrants a PTA credit of 423 days for PTO delay under 35 USC § 154(b)(1)(B) and 37 CFR § 1.702(b). Because these two periods of delay do not overlap, Applicants are entitled to the sum of these two periods. Accordingly, a total PTA credit of 790 days (i.e., 366 days + 424 days) is appropriate

based upon the PTO delay. The total number of PTA debits of 490 days for applicant delay that is shown on the PTA History (Exhibit A) is correct. Thus, the correct total PTA to date is 300 days.

3. Thus, Applicants believe that the total PTA credit for PTO delay is 790 days, the total PTA debit for applicant delay is 490 days, and the total PTA under 37 CFR § 1.703(f) is 300 days.

4. In accordance with 37 CFR § 1.705(b), this application for patent term adjustment is filed no later than the payment of the issue fee but after the date of mailing of the notice of allowance.

5. The following statements are required by 37 CFR § 1.705(b)(2)(i).

- i) The correct total PTA credit is 300 days.
- ii) The basis for the 366 days of PTA credit pursuant to § 1.702(a)(1) is due to the PTO's failure to mail a notification under 35 USC § 132 or a notice of allowance within 14 months of the application's filing date. The basis for the 424 days of PTA credit pursuant to § 1.702(b) is due to the PTO's failure to issue a patent within three years of the filing date.
- iii) The basis for the 490 days of PTA debit pursuant to § 1.704(b) is due to the Applicants' failure to reply to actions by the PTO within three months after the date on which the actions were mailed.
- iv) The total PTA under § 1.703(f) is projected to be 300 days, which is the total PTA credit for PTO delay of 790 days less the PTA debit for applicant delay of 490 days.

6. The following statements are required by 37 CFR § 1.705(b)(2)(ii).

- i) The relevant dates as specified in 37 CFR § 1.703(a)(1) for one part of the PTA credit are as follows: the date of March 22, 2005 which is the date that is fourteen months after the date on which the application was filed under 35 USC § 111(a); and the date of March 23, 2006, which is the mailing date of a notification under 35 USC § 121. Thus, the period of delay runs from March 22, 2005 to March 23, 2006. This period of delay is 366 days.
- ii) The relevant dates as specified in 37 CFR § 1.703(b) for the remaining part of the PTA credit are as follows: the date of January 22, 2007 which is the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a); and the date on which the Request for Continued Examination was filed on March 21, 2008. Thus, the period of delay runs from January 22, 2007 to March 21, 2008. This period of delay is 424 days.

7. The following statements are required by 37 CFR § 1.705(b)(2)(iv)(A) and list circumstances during the prosecution of this application constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-identified patent application as set forth in § 1.704.

- i) The Response to Notice to file Missing Parts filed September 28, 2004 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of the mailing of the Notice to File Missing Parts on April 28, 2004 and ends on the date the reply was filed. Thus, the period of delay runs from July 28, 2004 to September 28, 2004. Thus this period of delay is 62 days.
- ii) The Response to the Restriction Requirement filed August 23, 2006 under 37 CFR § 1.136(a) was filed after the three month period for filing a response. Under § 1.704(b), the period of

adjustment for delay associated with this reply begins on the day after the date that is three months after the date of the mailing of the Restriction Requirement on March 23, 2006 and ends on the date the reply was filed. Thus, the period of delay runs from June 23, 2006 to August 23, 2006. Thus this period of delay is 61 days.

- iii) The Amendment and Response to the Restriction Requirement filed February 26, 2007 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of the mailing of the Restriction Requirement on September 26, 2006 and ends on the date the reply was filed. Thus, the period of delay runs from December 26, 2006 to February 26, 2007. Thus this period of delay is 62 days.
- iv) The Amendment and Response filed July 6, 2007 under 37 CFR § 1.111 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of the mailing of the Non-Final Office Action on April 2, 2007 and ends on the date the reply was filed. Thus, the period of delay runs from July 2, 2007 to July 6, 2007. Thus this period of delay is 4 days.
- v) The Amendment and Response filed March 21, 2008 under 37 CFR § 1.111 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of the mailing of the Final Office Action on October 23, 2007 and ends on the date the reply was

filed. Thus, the period of delay runs from January 23, 2008 to March 21, 2008. Thus this period of delay is 58 days.

- (vi) The Amendment and Response filed October 21, 2008 under 37 CFR § 1.111 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of the mailing of the Non-Final Office Action on April 22, 2008 and ends on the date the reply was filed. Thus, the period of delay runs from July 22, 2008 to October 21, 2008. Thus this period of delay is 91 days.
- (vii) The Amendment and Response filed June 18, 2009 under 37 CFR § 1.111 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of the mailing of the Final Office Action on December 19, 2008 and ends on the date the reply was filed. Thus, the period of delay runs from March 19, 2009 to June 18, 2009. Thus this period of delay is 91 days.
- (viii) The Amendment and Response filed November 25, 2009 under 37 CFR § 1.111 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of the mailing of the Non-Final Office Action on June 25, 2009 and ends on the date the reply was filed. Thus, the period of delay runs from September 25, 2009 to November 25, 2009. Thus this period of delay is 61 days.

8. Any patent granted on this application is not subject to a terminal disclaimer. See 37 CFR § 1.705(b)(2)(iii)

9. Applicant reserves the right to file a supplemental Request for Correction of PTA under 37 CFR § 1.705(d) in the event the patent issues on a date other than September 13, 2010.

Respectfully submitted,

Date: 3/8/2010



J. Clinton Wimbish
Reg. No. 54,545

Encl. - Exhibit A - Copy of PTA History for Application No. 10/763,068 Printed from PAIR March 5, 2010

10/763,068	MONODISPERSE CORE/SHELL AND OTHER COMPLEX STRUCTURED NANOCRYSTALS AND METHODS OF PREPARING THE SAME	03-05-2010::16:05:43
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/763,068

Filing or 371(c) Date:	01-22-2004	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total PTA (days):	0
USPTO Adjustment(days):	-	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
02-16-2010	Mail Notice of Allowance		
02-05-2010	Document Verification		
02-05-2010	Notice of Allowance Data Verification Completed		
02-05-2010	Case Docketed to Examiner in GAU		
02-05-2010	Examiner's Amendment Communication		
01-14-2010	Date Forwarded to Examiner		
11-25-2009	Response after Non-Final Action	61	
11-25-2009	Request for Extension of Time - Granted	↑	
07-24-2009	Mail Examiner Interview Summary (PTOL - 413)	↑	
07-22-2009	Examiner Interview Summary Record (PTOL - 413)	↑	
06-25-2009	Mail Non-Final Rejection	↑	
06-23-2009	Non-Final Rejection		
06-19-2009	Date Forwarded to Examiner		
06-19-2009	Date Forwarded to Examiner		
06-18-2009	Request for Continued Examination (RCE)	91	
06-19-2009	Disposal for a RCE / CPA / R129	↑	
06-18-2009	Request for Extension of Time - Granted	↑	
06-18-2009	Workflow - Request for RCE - Begin	↑	
05-21-2009	Mail Advisory Action (PTOL - 303)	↑	
05-21-2009	Advisory Action (PTOL-303)	↑	
05-20-2009	Date Forwarded to Examiner	↑	
05-19-2009	Amendment after Final Rejection	↑	
05-19-2009	Request for Extension of Time - Granted	↑	
12-19-2008	Mail Final Rejection (PTOL - 326)	↑	
12-18-2008	Final Rejection		
11-08-2008	Date Forwarded to Examiner		
10-21-2008	Response after Non-Final Action	91	
10-21-2008	Request for Extension of Time - Granted	↑	
04-22-2008	Mail Non-Final Rejection	↑	
04-21-2008	Non-Final Rejection		
03-25-2008	Date Forwarded to Examiner		

03-25-2008	Date Forwarded to Examiner	
03-20-2008	Request for Continued Examination (RCE)	57
03-25-2008	Disposal for a RCE / CPA / R129	↑
03-20-2008	Request for Extension of Time - Granted	↑
03-21-2008	Workflow - Request for RCE - Begin	↑
10-23-2007	Mail Final Rejection (PTOL - 326)	↑
10-22-2007	Final Rejection	
10-17-2007	Date Forwarded to Examiner	
07-06-2007	Response after Non-Final Action	4
07-06-2007	Request for Extension of Time - Granted	↑
10-05-2007	Case Docketed to Examiner in GAU	↑
04-02-2007	Mail Non-Final Rejection	↑
03-29-2007	Non-Final Rejection	
03-10-2007	Date Forwarded to Examiner	
02-26-2007	Response to Election / Restriction Filed	62
02-26-2007	Request for Extension of Time - Granted	↑
09-26-2006	Mail Restriction Requirement	↑
09-22-2006	Requirement for Restriction / Election	
12-14-2004	Information Disclosure Statement considered	
09-05-2006	Case Docketed to Examiner in GAU	
09-05-2006	Transfer Inquiry to GAU	
08-31-2006	Date Forwarded to Examiner	
08-23-2006	Response to Election / Restriction Filed	61
08-23-2006	Request for Extension of Time - Granted	↑
03-23-2006	Mail Restriction Requirement	366
03-20-2006	Requirement for Restriction / Election	↑
03-11-2005	Receipt of all Acknowledgement Letters	↑
12-14-2004	Reference capture on IDS	↑
12-14-2004	Information Disclosure Statement (IDS) Filed	↑
12-14-2004	Information Disclosure Statement (IDS) Filed	↑
01-06-2005	IFW TSS Processing by Tech Center Complete	↑
01-06-2005	Case Docketed to Examiner in GAU	↑
10-15-2004	Application Return from OIPE	↑
10-18-2004	Application Is Now Complete	↑
10-15-2004	Application Return TO OIPE	↑
10-15-2004	Application Return from OIPE	↑
10-15-2004	Application Return TO OIPE	↑
10-15-2004	Application Return from OIPE	↑
10-15-2004	Application Is Now Complete	↑
10-15-2004	Application Return TO OIPE	↑
10-15-2004	Application Dispatched from OIPE	↑

10-15-2004	Application Is Now Complete	↑
09-28-2004	Payment of additional filing fee/Preeexam	62
09-28-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑
08-25-2004	Receipt of Acknowledgment Letter	↑
07-07-2004	Receipt of Acknowledgment Letter	↑
04-28-2004	Notice Mailed--Application Incomplete--Filing Date Assigned	↑
03-22-2004	Referred by L&R for Third-Level Security Review. Agency Referral Letter Generated	
03-22-2004	Referred by L&R for Third-Level Security Review. Agency Referral Letter Generated	
03-22-2004	Referred by L&R for Third-Level Security Review. Agency Referral Letter Generated	
03-09-2004	Referred to Level 2 (LARS) by OIPE CSR	
02-03-2004	IFW Scan & PACR Auto Security Review	
01-22-2004	Initial Exam Team nn	

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